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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/921,542	08/03/2001	Daniel L. Schwarz	P-5204	6838

26253 7590 01/09/2004

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FRANKLIN LAKES, NJ 07417-1880

EXAMINER
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SORKIN, DAVID L

ART UNIT	PAPER NUMBER
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1723

DATE MAILED: 01/09/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

AS

<b>Office Action Summary</b>	Application No. 09/921,542	Applicant(s) SCHWARZ ET AL.	
	Examiner David L. Sorkin	Art Unit 1723	

-- The MAILING DATE of this communication appears on the cover sheet with the corresponding address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 23 December 2003.
- 2a) ☐ This action is FINAL.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. §§ 119 and 120**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) ☐ All   b) ☐ Some \* c) ☐ None of:  
     1. ☐ Certified copies of the priority documents have been received.  
     2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
     3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
 a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                             | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 23 December 2003 has been entered.

### ***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1 and 6-10 are rejected under 35 U.S.C. 102(b) as being anticipated by Ilg (US 3,328,255). Regarding claim 1, Ilg ('255) discloses a system comprising a sample vessel (2); a sample vessel holder (98), adapted to receive at least on said sample vessel and maintain said sample vessel in a position such that the longitudinal axis of said sample vessel extends at an angle substantially less than 90 degrees with respect to horizontal (see col. 8, lines 56-66); a stirrer (94) within said sample vessel; and a magnetic drive (96), adapted to move a magnet proximate to an outer surface of said sample vessel to permit said magnet to impose a magnetic influence on said stirrer to move said stirrer in said sample vessel, wherein said magnet rotates about an axis

90 degrees with respect to the longitudinal axis of said sample vessel (see col. 8, lines 45-70; Figs. 1 and 2). While Ilg ('255) happens to explicitly disclose the angle of the sample vessel being substantially less than 90 degrees with respect to horizontal as discussed above, because the claim does not require an this angle of the vessel relative to any other claimed element, it is considered that the recited angle is a matter of intended use. It is also noted that the claim does not recite the angle with respected to the claimed vessel, but instead with respect to an adaptation or capability of the holder to hold a vessel at an angle of substantially less than 90 degrees. "The manner or method in which such machine is to be utilized is not germane to the issue of patentability of the machine itself" *In re Casey* 152 USPQ 235 (CCPA 1967). Also, "recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus" *Ex parte Masham*, 2 USPQ2d 1647 (Bd. Pat. App. & Inter. 1987). Further regarding the other "angle" recitation, "said magnet rotates about an axis 90 degrees with respect to the longitudinal axis of said sample vessel", it is noted that, while the reference disclosed rotation about an axis having the claimed angle, "said magnet" is not positively recited as part of the claimed system, but instead regarding what the "driver" is "adapted to move". Claims 6, 7, 9 and 10 further discuss what the claimed device is intend to do; however, "apparatus claims cover what a device *is*, not what a device *does*" (emphasis in original) *Hewlett-Packard Co. v. Bausch & Lomb Inc.* 15 USPQ2d 1525, 1528 (Fed. Cir. 1990). Nonetheless, as best seen in Fig. 2, the magnet driver of Ilg ('255) is adapted to move said magnet such that said mangetic influence moves said

Art Unit: 1723

stirrer along a side wall of said sample vessel as stipulated in claim 6. Likewise, the system of Ilg ('255) is capable of being used in the manner discussed in claims 7, 9, and 10. Claim 8 only discusses a magnet which is not recited as part of the claimed apparatus and therefore does not further structurally limit the claimed apparatus.

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ilg (US 3,328,255) in view of Rosinger (US 2,350,534). The system of Ilg ('255) was discussed above with regard to claim 1. While it is considered that Ilg ('255) discloses all the limitations of claim 1 as set forth above, it is alternatively considered that the claim would have been obvious to one of ordinary skill in the art in view of Rosinger ('534). Specifically, it is considered that it would have been obvious to have provided a driver according to the teachings of Rosinger ('534) as the "rotating magnetic field generating device 96 of conventional design" of Ilg ('255) (quoting from col. 8, lines 50-52). Rosinger ('534) teaches a system including a magnetic driver (14, 15, 26) and stirrer (29). The magnetic driver (14,15) is adapted to drive a magnet (25). It is considered that it would have been obvious to one of ordinary skill in the art to have provided a magnet driver according to the teachings Rosinger ('534) as the "rotating magnetic field generating device 96 of conventional design" of Ilg ('255), because the

Art Unit: 1723

term "convention design" would have suggested to one of ordinary skill in the art to look to conventional magnet drivers such as that of Rosinger ('534). Regarding claim 2, in the driver taught by Rosinger ('534), a magnet shaft assembly (15, 26) has a magnet (25) coupled thereto; and a motor (14). Regarding claim 3, said magnet shaft assembly (15,26) is rotatable (see col. 2, lines 24-31). Regarding claim 4, one of ordinary skill in the art would understand the "electric motor 14" of Rosinger ('534) necessarily involves electromagnetic coupling on the motor to shaft 15 of the magnet shaft assembly.

Regarding claim 5, Rosinger ('534) further teaches a stirrer including a ferrous metal (see col. 1 of page 2, line 21). Claims 6, 7, 9 and 10 further discuss what the claimed device is intend to do; however, "apparatus claims cover what a device *is*, not what a device *does*" (emphasis in original) *Hewlett-Packard Co. v. Bausch & Lomb Inc.* 15 USPQ2d 1525, 1528 (Fed. Cir. 1990). Claim 8 only discusses a magnet which is not recited as part of the claimed apparatus and therefore does not further structurally limit the claimed apparatus.

### ***Response to Arguments***

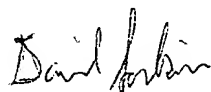
6. Applicant states regarding Ilg ('255) that "Ilg clearly teaches that the vessel therein is positioned at a angle of 90 degrees to the horizontal". Applicant makes no attempt to point out where the reference makes such a teaching. Oppositely, Fig. 2 clearly depicts a non-horizontal angle of approximately 45 degrees and col. 8, line 60 explicitly recites "45° to horizontal" (emphasis added).

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David L. Sorkin whose telephone number is 571-272-1148. The examiner can normally be reached on 9:00 -5:30 Mon.-Fri..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wanda L. Walker can be reached on 571-272-1151. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

A handwritten signature in black ink, appearing to read "David Sorkin". The signature is written in a cursive, flowing style.

David Sorkin